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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,025	12/15/2003	Thomas E. Creamer	BOC9-2003-0069 (440)	4173
40987	7590	12/07/2007	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188				GOODCHILD, WILLIAM J
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/736,025	CREAMER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	WILLIAM J. GOODCHILD	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 September 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-23 and 38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16-23 and 38 can be considered to be software in accordance with applicants specification, (paragraph 0045, lines 1-2, "The present invention can be realized in hardware, software, or a combination of hardware and software"). In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Galli et al., (US Publication No. 2005/0086309), (hereinafter Galli).

In reference to claim 14, Galli teaches a method comprising: one or more instant messaging clients configured to publish a transcript generated during an instant messaging session, (paragraph 109); a server configured to establish an on-line interactive communication session between at least two of the instant messaging clients, (paragraph 37, lines 1-4, figure 1A); and a server configured to receive the transcript from the instant messaging client, (paragraph 37, lines 13-15, figure 1A). The IMLet, when registered by a user of the RIM service, runs on the top of the RIM service application); wherein within an instant messaging session, at least one of said instant messaging clients automatically publishes a transcript of the instant messaging session to the server responsive to a user request or a scheduled event, (paragraph 109).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-13, 15-17, 19-26 and 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linsey et al., (US Patent No. 6,791,582), (hereinafter Linsey), and further in view of Galli et al., (US Publication No. 2005/0086309), (hereinafter Galli) and "Blogging: Genius Strategies for Instant Web Content", by Biz Stone, Publisher: New Riders, Pub. Date: September 11, 2002, (hereinafter Stone).

Regarding claims 1, 15, 16 and 24, Linsey teaches a method / system comprising: (a) establishing an instant messaging session [Linsey, column 2, lines 37-38, column 30, line 64 – column 31, line 6, a system which facilitates instant messaging using a chat session]; (b) receiving a user request to publish a transcript of the session to at least one of a plurality Weblogs [Linsey, column 32, lines 25-27, Users may be allowed to copy the transcripts of a chat into a QuickPlace page, or to save the chat as a whole as a page, column 5, lines 11-13]. Linsey does not specifically disclose (c) determining a destination of the at least one Weblog.

However, Galli, discloses publishing Web content to any HTML Web site [Galli, column 3, lines 3-5]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a third party service in order to enhance the instant messaging experience.

Additionally, Linsey does not specifically disclose (d) generating an indicator indicating at least one of a format, font, and color in which the transcript is to be published; and (e) publishing the transcript to the at least one Weblog according to the indicator.

However, Stone, discloses using a predefined template [Stone, chapter 16, 3<sup>rd</sup> paragraph under “Template Management Systems: The Future of Site Management”, “WebCrimson goes beyond blogging in that you are allowed to create almost any type of site. Here is a list of WebCrimson’s standard features:”, “Automated templating technology for generating whole new areas of your site with a consistent look and feel including: Single Entry templates, Index templates, Blog templates”]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of a predefined template in order to separate design from content.

In reference to claims 2 and 25, Linsey further teaches said steps (a), (b), and (c) are performed by an instant messaging client [Linsey, column 2, lines 37-38, a system which facilitates instant messaging].

In reference to claims 3, 17 and 26, Linsey further teaches saving the transcript to a portion of memory that is local to the instant messaging client [Linsey, column 32, lines 35-31, Users may be allowed to copy the transcripts of a chat].

In reference to claims 5, 19 and 28, Linsey further teaches receiving a second user input requesting that the transcript be sent to the Weblog; and sending the transcript to the Weblog [Linsey, column 32, lines 25-31, Users may be allowed to copy the transcripts of a chat].

Regarding claims 6 and 29, Linsey-Galli-Stone further disclose formatting the transcript according to a predefined template [Stone, chapter 16, 3<sup>rd</sup> paragraph under “Template Management Systems: The Future of Site Management”].

Regarding claims 7 and 30, Linsey-Galli-Stone further disclose the predefined template specifies one of a plurality of Weblogs to which the transcript is published or one of a plurality of sections of a Weblog to which the IM transcript is stored [Stone, chapter 16, 3<sup>rd</sup> paragraph, “WebCrimson goes beyond blogging in that you are allowed to create almost any type of site. Here is a list of WebCrimson’s standard features:”, “Automated templating technology for generating whole new areas of your site with a consistent look and feel including: Single Entry templates, Index templates, Blog templates”]

Regarding claims 8 and 31, Linsey-Galli-Stone further disclose the template specifies instructions for processing the Weblog according to the identity of the sender [Stone, chapter 18, 4<sup>th</sup> paragraph, “Posting via AIM™” and Figure 18.1].

Regarding claims 9, 20 and 32, Linsey-Galli-Stone further disclose exchanging electronic documents within the instant messaging session, wherein the electronic document is saved as part of the transcript [Galli, paragraph 51, lines 1-3 and paragraphs 77-84].

Regarding claims 10 and 33, Linsey-Galli-Stone further disclose electronic document specifies multimedia content [Galli, paragraph 58, figure 4, a movie link is specified].

Regarding claims 11, 21 and 34, Linsey-Galli-Stone further disclose joining a Weblog agent to the instant messaging session, wherein the Weblog agent records transactions of the instant messaging session [Galli, paragraph 20, lines 1-3, paragraph 116, lines 2-5].

Regarding claims 12, 22 and 35, Linsey-Galli-Stone further disclose sending the transcript to the Weblog using the Weblog agent [Galli, paragraph 109].

Regarding claims 13, 23 and 36, Linsey-Galli-Stone further disclose formatting the transcript according to a template using the Weblog agent [Stone, chapter 16, 3<sup>rd</sup> paragraph, “WebCrimson goes beyond blogging in that you are allowed to create almost any type of site. Here is a list of WebCrimson’s standard features:”, “Automated templating technology for generating whole new areas of your site with a consistent look and feel including: Single Entry templates, Index templates, Blog templates”].

6. Claims 4, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linsey-Galli-Stone as applied to claims 3, 17 and 26 above, and further in view of Lehikoinen et al., (US Patent No. 7,069,003), (hereinafter Lehikoinen).

Regarding claims 4, 18 and 27, Linsey-Galli-Stone discloses detecting a state change in the portion of memory [Linsey, column 6, lines 46-63]. Linsey-Galli-Stone does not specifically disclose detecting a state change in the portion of memory. However, Lehikoinen, discloses the use of tracking events used as the basis for updating the user's blog [Lehikoinen, column 4, lines 40 and 51-52]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of tracking events in order to update a blog automatically.

7. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galli, and further in view of Lehikoinen.

Regarding claims 37-39 Galli disclose establishing an instant messaging session [Galli, paragraph 48, lines 2-5, User A at the device 21 (of figure 2), and User B at the device 22 are communicating across the Internet 23 in an instant messaging session]. Galli does not specifically disclose detecting a scheduled event; and publishing the transcript to a Weblog responsive to detecting the scheduled event. However, Lehikoinen, discloses the use of tracking events used as the basis for updating the user's blog [Lehikoinen, column 4, lines 40 and 51-52]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of tracking events in order to update a blog automatically.

***Response to Arguments***

8. Applicant's arguments, filed 09/21/2007, with respect to 101 rejection of claims 15, 24-33 and 39 have been fully considered and are persuasive. The 101 rejection of claims 15, 24-33 and 39 have been withdrawn.

9. Applicant's arguments filed 09/21/2007 have been fully considered but they are not persuasive.

A – Applicant argues “The claims use ‘means for’ language”, “the claims should be given their broadest reasonable interpretation” and “Specification, paragraph [0026] describing the necessary hardware for establishing an instant messaging session, which is a element of the claims.”.

A – Applicants specification paragraph 45, lines 1-2 state that the system can be implemented with hardware, software or a combination of both and the claims do not specifically state a piece of hardware is required.

10. Applicant's arguments with respect to claims 1-13 and 15-36 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant failed to argue with respect to claims 1-3, 9-12, 15-17, 20-22, 24-26, 32-35 with respect to Galli. As the independent claims (1, 15, 16 and 24) have been amended, new grounds of rejection have been established. As claims 4, 14, 18 and 27

are dependent on amended claims, new grounds of rejection have been established also.

12. Applicant's arguments with respect to claims 4, 14, 18, 27, 37-39 with respect to Galli have been fully considered but they are not persuasive as the submitted declaration has been found to be ineffective to overcome the Galli reference.

***Response to Amendment***

13. The Declaration filed on September 21, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Galli reference.

14. The declaration is not made on behalf of all inventors of the claimed subject matter. All inventors must sign the declaration.

15. Item 6 of the declaration states that the invention was conceived as early as February 23, 2003, item 4 states that the Invention Disclosure was modified on March 13, 2003. It is unclear what date is being requested and evidence showing conception on February 23, 2003 and changes made on March 13, 2003 are not provided.

16. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Galli reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be

comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

- a. The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice are unsupported by proof or a showing of facts and, thus, do not satisfy the requirements of 37 CFR 1.131.
17. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Galli reference to either a constructive reduction to practice or an actual reduction to practice.
  - b. An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter was diligently reduced to practice is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts)).

***Conclusion***

**18. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. GOODCHILD whose telephone number is (571)270-1589. The examiner can normally be reached on Monday - Friday / 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WJG  
12/04/2007

/Jason D Cardone/  
Supervisory Patent Examiner,  
Art Unit 2145